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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)
GILBERT P. HYATT) Group Art Unit: 2621
Serial No. 08/464,034) Examiner: Brian Werner
Docket No. 751)
Filed: June 5, 1995)
For: IMPROVED IMAGE PROCESSING)
ARCHITECTURE)

)

PETITION FOR WITHDRAWAL OF THE FINALITY OF
THE PREMATURE FINAL ACTION

Hon. Commissioner For Patents
P.O. Box 1450, Alexandria, VA 22313-1450

Sir:

The Examiner generated a final Action dated March 9, 2005; but the finality of this Action is premature. Hence, the Applicant respectfully petitions for withdrawal of the finality of the Action and for an opportunity to fully respond to the instant Action under 37 CFR 1.111. Points and authorities and good and sufficient reasons are set forth hereinafter.

The requirements for a final Action are set forth by the PTO (MPEP 706.07(a) (emphasis added)):

... second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.

However, the Examiner has violated these requirements by entering new grounds of rejection in the final Action which were not necessitated by amendment nor based upon information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Thus the finality of the Action is premature and must be withdrawn. See the two examples below.

As a first example, deletions have been made to claims 211, 258, 381, 388, 398, 422, 427, 472, 536, 556, 557, 558, 559, 560, 563, 564, 565, 567, 568, 569, 570, 575, 576, 577, 578, 579, 580, 581, 582, and 583 without necessitating the new grounds of rejection in the final Action. This is because the remaining "subject matter" after the deletions was in these claims before the amendment and thus is "substantially the same subject matter". These claims may also have non-substantial amendments since the previous action on the merits which certainly did not necessitate the new grounds of rejection in the final Action. Consequently the finality of the rejection of these claims is premature (MPEP 706.07). This issue of "substantially the same subject matter" is further discussed below.

As a second example, the antecedent basis amendments made to claims 195, 219, 232, and 276 certainly did not necessitate the new grounds of rejection in the final Action because antecedent basis amendments merely conform the claims to "subject matter" that is already recited in the claims and such amendments do not change claim scope. Thus, these claims have "substantially the same subject matter" and consequently the final rejection is premature (MPEP 706.07). This issue of "substantially the same subject matter" is further discussed below.

The new grounds of rejection in the final Action violate MPEP 706.07 (emphasis added) :

Switching ... from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attending the goal of reaching a clearly defined issue for an early termination. i.e., ... a final rejection.

The two above examples identify claims with "substantially the same subject matter" (non-substantial "subject matter" may have been added to these claims) and thus the "[s]witching" to another

set of references defeats "a final rejection".¹ Consequently, the final rejection is defeated and must be withdrawn. Thus, this defeated "final rejection" must be withdrawn.

In view of the above, "a clear issue" has not been developed, the Applicant has not received "the cooperation of the examiner", and the Applicant is being deprived of "a full and fair hearing" to which he is "entitled". The Examiner is prematurely cutting off the prosecution of the application (MPEP 706.07 (emphasis added)):

Before final rejection is in order a clear issue should be developed between the examiner and applicant.... The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application....

The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.

Thus, as shown above, this defeated "final rejection" must be withdrawn.

In view of the above, the finality of the Action is premature. Thus, the finality of the Action should be withdrawn and the Applicant should be given an opportunity to fully respond to the instant Action such as under 37 CFR 1.111 and not be prematurely cut off.

1. Regardless of whether deletion of claim limitations may change the scope of a claim, it does not change the "subject matter" of the claim. Because it is the "subject matter" of the claim, not the scope of the claim, that determines the issue of a premature final Action in MPEP 706.07, an amendment that deletes "subject matter" from a claim does not in itself condone a final rejection.

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CERTIFICATION OF MAILING BY EXPRESS MAIL: I hereby certify that this correspondence is being deposited with the United States Postal Service with Express Mail post office to addressee service under 37 CFR 1.10, postage prepaid, in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 with the express mail label number EV 323876624 on May 9, 2005.

Respectfully submitted,

Dated: May 9, 2005



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